

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/709,433

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Art Unit: 2177

Applicants: Stewart et al.

Examiner: Queler, Adam M.

Title: System, method and recordable
medium for printing services over a
network and graphical user interface

Docket No.: MIME-0003

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

Sir:

This paper is being filed in response to the Decision on Appeal dated 2 November 2011 and subsequent Decision on Request for Rehearing dated 13 January 2012. Appellants thank the Board for its consideration and reversals of the Examiner's rejections of claims 41; and 13, 14, and 37-40. However, Appellants again request reconsideration of the rejections of claims 12, 15, 16, and 32-34 for the following reasons.

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| 1. <i>Superguide Corp. vs. DirecTV Enterprises, Inc.</i> , 358 F.3d 870, 69 USPQ2D (BNA) 1865 (Fed. Cir. 2004). | p. 6 |
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Argument

Claim 12

On p. 4, lines 13-16 of the Board's Decision on Request for Rehearing dated 13 January 2012 (hereinafter "Decision"), the Board states, when addressing claim 12, "we conclude that claim 12 is subject to two alternative interpretations regarding the scope of 'an application configured to at least one of:' and the language that immediately follows." Decision, p. 4, lines 13-16. The Board goes on to "reverse *pro forma* the Examiner's obviousness rejection of independent claim 12..." Decision, p. 5, lines 10-12.

Appellants respectfully request reconsideration of the Board's *pro forma* reversal of the Examiner's rejections for the following reasons:

A. The Board's alternative interpretation regarding the scope of the "an application configured to at least one of" clause is not plausible.

In holding the claim as having more than one plausible interpretation, the Board states "[w]e note that Appellants have addressed both interpretations in the Request and even propose 'removing and/or modifying the 'at least one of' language' by amendment. Thus, on this record, we conclude that both interpretations of the aforementioned language of claim 12 are plausible." Decision, p. 4, lines 18-22. The Board appears to contend that its alternative interpretation is plausible because: (a) Appellants address both interpretations in the Request; and (b) Appellants 'propose' to amend the claim. Neither of these reasons supports such a holding that the Board's alternative interpretation is plausible.

Regarding the fact that Appellants address both interpretations in the Request for Rehearing dated 3 January 2012 (hereinafter "Request"), Appellants' were required to

address the Board's alternative interpretation since that was the basis of the Board's rejection in the original Decision on Appeal dated 2 November 2011. The fact that Appellants addressed the Board's holding in the Request provides no support for the plausibility of the interpretation. In contrast, as clearly described in the remarks, Appellants argue that the interpretation was not plausible based on at least two alternative reasons. See, e.g., Request, pp. 5-7 stating that: (1) the Board's construction of the providing system software clause of claim 12 is not grammatically correct and renders the clause meaningless; and (2) the Board's construction of the providing system software clause of claim 12 is not reasonable when viewed in light of the specification.

Appellants also included a third argument in which the Board's decision was, merely for the sake of argument, assumed to be reasonable, as well as a discussion of a remedy for the Board's interpretation of the claim. Request, pp. 8-9. However, neither of these arguments explicitly or implicitly supports a finding that the Board's construction is at all plausible. In contrast, both of these arguments were included in Appellants' failed attempt to ensure that the Board consider the core issue of the Appeal, namely, the interpretation by the Examiner that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests all of the acts provided by the system software of claim 12.

In light of the above, Appellants respectfully submit that the Board's Decision fails to address Appellants' arguments presented in the Request. To this extent, Appellants reiterate each of the arguments included in the Request with respect to the Board's proposed alternative interpretation of claim 12 and respectfully request reversal of the

Board's rejection of claim 12 and claims 15, 16, and 32-34, which depend therefrom, as allegedly having more than one plausible interpretation.

B. The USPTO Goal of Compact Prosecution Requires the Board to Resolve the Core Issue of the Appeal

Appellants respectfully submit that conformance with the USPTO's explicitly stated goal of Compact Prosecution, in which Examiners are encouraged "to find the core issues in a patent application and resolve them early in their prosecution," (see, e.g., "Strategic Goal 1: Optimize Patent Quality and Timeliness," available at http://www.uspto.gov/about/stratplan/ar/2010/mda_02_03.html) requires the Board to consider and resolve the core issue of this Appeal.

In particular, Appellants and the Examiner have clearly identified and fully briefed the Board on their respective positions of whether the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests all of the acts provided by the claimed system software. Furthermore, as previously noted by the Appellants, nothing in the Board's proposed alternative interpretation of the claim changes the requirement that each of the elements in the list be taught or suggested by the Examiner's proposed combination of the two embodiments of Adamske and Tonkin. See, e.g., *Superguide Corp. vs. DirecTV Enterprises, Inc.*, 358 F.3d 870, 69 USPQ2D (BNA) 1865 (Fed. Cir. 2004) (holding that 'at least one of' followed by a list of categories separated by the term 'and' requires each element in the list be fulfilled). Additionally, nothing in the Board's Decisions regarding this Appeal will alter either the Appellants' or the Examiner's contentions.

The Board's Decisions to date merely serve to delay resolution of the core issue in this patent application. Appellants have argued this issue extensively with the

Examiner during prosecution. There is no indication that any amount of further arguments or prosecution will change the positions of Appellants or Examiner. As a result, a resolution of the core issue, should the Board fail to address and resolve the respective contentions of Appellants and the Examiner in the current Appeal, will likely undergo unnecessary delay while Appellants file yet another Appeal, in which the same arguments are again presented to the Board by both the Appellants and the Examiner. Imposing such a delay on Appellants goes against the USPTO's policy of resolving core issues in a patent application early in its prosecution.

In light of the above, Appellants respectfully request that the Board now consider the core issue in this patent application during the present appeal.

Conclusion

In summary, Appellants respectfully request reconsideration of the rejections of independent claims 12, and claims 15, 16, and 32-34, which depend therefrom, and submit that these claims are allowable over the cited art because the Examiner's use of the proposed combination of the two embodiments of Adamske and Tonkin fails to present a *prima facie* showing that each element of the claimed inventions is taught or suggested by the cited art and the Board's previous alternative construction and/or analysis of claim 12 is deficient for the reasons stated herein.

Respectfully submitted,

/John LaBatt/

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